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EXAMINER

FISHER, MICHAEL J

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3629

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/472,900
Filing Date: December 28, 1999
Appellant(s): SAKO, KAZUE

Ronald Coslick (reg#36,489)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/28/04.

(1) *Real Party in Interest*

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A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 1-10 have been rejected three times over Franklin, 11-14 were added in the amendment filed 10/31/03.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

Whether claim 9 is unpatentable under 35 U.S.C. 102 over Franklin et al.

Whether claims 1-8 and 10-14 are unpatentable under 35 U.S.C. 103 over Franklin et al.

Note: The appellant's statement of issues includes arguments as to why they should not be rejected. The statement of issues should include a concise statement of the issues presented for review such as, 'Whether claims 1 and 2 are unpatentable under 35 U.S.C. 103 over Smith in view of Jones.'

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because appellant argues the claims differently than grouped. Specifically, the appellant argues claim 9, and with it its dependent claims 11 and 12 while arguing claims 1 and 10 together. Therefore, the proper grouping would be

Claims 9,11 and 12 stand or fall together.

Claims 1-8,10,13 and 14 stand or fall together.

Note: The reasons they do not stand or fall together are provided in the section 5. titled "Summary of the Invention" and not in section 7. titled "Grouping of the Claims."

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

6,055,518

Franklin et al.

4-2000

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 9 is rejected under 35 U.S.C. 102(e) as being anticipated by Franklin et al. (Franklin).

Franklin discloses a method for placing a bid comprising the bidder determining, or choosing, a bid price (col 8, lines 47-53), obtaining a code parameter corresponding to the bid price (col 10, lines 40-47), this parameter would inherently be predetermined as the parameter corresponds to a particular bid as each bid would have an ASCII or HTML code associated with it (both for amount and bidder), encoding the bid with the code parameter and transmitting the encoded bid to a bid-receiving system (S).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-8 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin.

Franklin discloses an electronic tender system comprising bidder sub-systems (B), including a code parameter acquisition section for receiving a bid and for acquiring a code parameter corresponding to the bid, this parameter would inherently be predetermined as it corresponds to a bid, a code processing section for using the code parameter to encode the bid and a transmission section for sending the bid to a tender opening sub-system (see col 2, line 61-col 3, line 49, and further, col 8, lines 47-53 and further, claims 1 and 5), and a tender opening sub-system (S), including a reception section for receiving messages from the bidder sub-systems until a closing time, a candidate price selection section (col 9, lines 3-52), a decode parameter acquisition section and a determination section for decoding encoded bids (see col 10, line 52-col 11, line 15 and further, claim 10). The code parameters would inherently be predefined, (such as ASCII or HTML codes), and further. There would be different codes for bidders and for bids, as both would have different objects encoded and these codes would inherently be associated with each other so that a winning bid would be related to a bidder to ascertain who won the bid.

As to claims 3 and 4, public and private keys are disclosed (see col 4, lines 19-38 and claim 14).

As to claims 5-8, an announcement section is disclosed (see col 9, line 53-col 10, line 2).

As to claim 11, the public key would be that which the bidder would use to place the bid.

As to claim 12, the bid would be encoded as this would make it comprehensible to a computer.

As to claim 13, a secret key would be that which is only used by the site's administrators, as is discussed in col 4, lines 11-16).

As to claim 14, codes would be decoded by the computer to allow the site administrators to read the bids.

Note: The rejection to claims 1-8 and 10 through 14, while presented as a rejection under 35 USC 103 is considered a rejection under 35 USC 102.

(11) Response to Argument

While the claims are to be interpreted in light of the specification, they are given their broadest possible interpretation by the examiner.

As to arguments in relation to claim 9, the **codes** discussed, ASCII (**A**merican **S**tandard **C**ode for Information Interchange), HTML, etc. are **predefined** and would be associated with the **bid**. Thus, in ASCII, the binary code for the letter 'A' would always be 101, or 65 in regular, decimal notation. The computer can't read the letter 'A', it reads it as a binary **code**. The **code parameter** would therefore, inherently, be different for each bid price. A computer automatically changes the ASCII **code** from its memory into a form readable by a user on the monitor. Computers only understand numbers so the


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ASCII **code** translates from the binary numbers a computer can understand to symbols shown on the screen. Therefore, each different symbol (whether a number, punctuation mark, letter or symbol such as a dollar sign) would have a different **code** associated with it. The **code parameter** would represent the bid and be associated with it, but would be different from the bid.

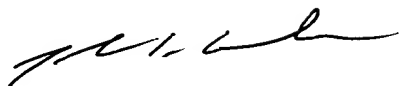
As to the arguments in relation to claims 1 and 10, as is discussed above, a computer inherently changes everything into a **code**, for instance, ASCII. This would meet the limitations as claimed. The computer would further, inherently, decode the bids as they were transmitted to the computer so the computer could display them. Further, if the bids are erased, they would not be displayed and therefore, would not be decoded as the computer would not need to display them. The examiner disagrees that he is confusing the bid information with the code parameter. The computer would code the bid in ASCII and thus meet the limitations as claimed.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

MF 
September 20, 2004

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